

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q89568
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____	Application Number 10/553,398	Filed August 31, 2006
	Confirmation Number: 8985 First Named Inventor Giuseppe LO BIUNDO	
Signature Typed or printed name	Art Unit 3746	Examiner WEINSTEIN, LEONARD J

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

☒ The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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Direct all correspondence to the address for SUGHRUE MION, PLLC filed under the Customer Number listed below:

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I am the

<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. <input type="checkbox"/> Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number 55,154 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	_____ /David P. Emery/ Signature _____ David P. Emery Typed or printed name _____ (202) 293-7060 Telephone number _____ September 29, 2011 Date
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

<input checked="" type="checkbox"/> *Total of <u> 1 </u> form is submitted.

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q89568

Giuseppe LO BIUNDO, et al.

Appln. No.: 10/553,398

Group Art Unit: 3746

Confirmation No.: 8985

Examiner: WEINSTEIN, LEONARD J

Filed: August 31, 2006

For: OIL AND VACUUM PUMPS GROUP FOR A MOTOR VEHICLE ENGINE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated June 29, 2011, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

I. Claim Rejections under 35 U.S.C. § 103

Claims 1, 2, 4-6, 8, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitefield US 5,282,46 in view of Schneider US 6,345,600 as evidenced by Garza US 5,535,643, further in view of Sato US 5,941,203, still further in view of Hayman et al. US 6,602,557.

In response, Applicants submit the Examiner has failed to establish prima facie obviousness because one of ordinary skill in the art **would not place a gear between an oil pump and a vacuum pump based on Hayman's disclosure.**

Specifically, the vanes 58 relied on by the Examiner as the alleged “secondary pump”, are merely used to expel any oil through the top that enters the enclosure through the top. This is **nowhere even remotely related to the oil pump and vacuum pump as disclosed by Schneider**. There is no inlet separate from an outlet. In fact, this construction (vanes on 58) merely expels oils through the same inlet that receives the oil. Construing these vanes on driving gear 48 as a pump in the same vein as the oil and vacuum pumps disclosed by Schneider or Whitefield is improper. Moreover, even if gear 48 could be construed as a pump – it would not be between a vacuum pump and an oil pump – instead, the gear 48 is itself the pump. In other words, even if the Examiner could construe gear 48 and vanes 58 as a vacuum pump (which it is not) it would only be adjacent an oil pump, not between a vacuum pump and an oil pump.

Claim 1 recites, *inter alia*, wherein said gear is operatively placed on the monolithic motion transmission shaft between said at least one oil pump and said at least one vacuum pump.

With regard to the cited references, neither Whitefield, Schneider, Garza nor Sato disclose a drive gear disposed on a monolithic shaft between two pumps. Notably, the only references that disclose both an oil pump and a vacuum pump are Whitefield and Schneider. However, these references **both** position their drive members, i.e., input drive member 20 and driving sprocket 22 **at a distal end of the shaft**. In other words, neither of the oil pump/vacuum pump combinations disposed their drive member between the two pumps of this type.

To compensate for the deficiencies of these references, the Examiner relies on Hayman. In particular, the Examiner attempts to rely on Hayman’s driven gear 48 as a pump member. In this regard, while Hayman’s driven gear includes vanes 58 to regurgitate oil that enters the top,

out through the top to keep it away from the gear, this is not a “pump” in the same vein as a “a vacuum pump” or “oil pump.”

Accordingly, one of ordinary skill in the art would not modify either Whitefield or Schneider in view of Hayman to place the input drive member 20 (Whitefield) or driving sprocket 22 (Schneider) between an oil pump or vacuum pump. Rather, these vanes 58 do not function to pump oil from an inlet to an outlet. In other words, one of ordinary skill in the art would not correlate these scavenging vanes 58 to the oil pump of either Whitefield or Schneider. The Examiner’s reading of Hayman is unreasonable in this regards.

Further evidencing that Hayman does not teach placing a driven gear 48 between two pumps is Hayman’s express disclosure:

At one end of the shaft, adjacent the first oil pump, a driven gear 48
is bolted.
Col. 2, lines 30-32.

In this regard, Hayman is consistent with the disclosures of both Schneider and Whitefield in that the drive member is placed at the end of the shaft, not between two pumps. Consequently, the Examiner has failed to establish *prima facie* obviousness for at least this reason.

Respectfully submitted,

/David P. Emery/

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